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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,264	06/26/2002	Jason A. Gordon	F-506	1239
919	7590	08/16/2006	EXAMINER	
PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			JABR, FADEY S	
		ART UNIT		PAPER NUMBER
		3639		
DATE MAILED: 08/16/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/064,264	GORDON, JASON A.
	<b>Examiner</b>	<b>Art Unit</b>
	Fadey S. Jabr	3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 June 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-13 and 16-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/26/02</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Status of Claims*

Claims **14-15** have been cancelled. Claims **1, 4, 10 and 16** have been amended. Claims **1-13 and 16-20** remain pending and are again presented for examination.

### *Response to Arguments*

1. Applicant's arguments (with respect to claims 3-4) filed 9 June 2006, with respect to the rejection under 35 U.S.C. section 112, second paragraph, have been fully considered and is therefore withdrawn.
2. Applicant's arguments (with respect to claim 5) filed 9 June 2006, with respect to the rejection under 35 U.S.C. section 112, second paragraph, have been fully considered and are not persuasive and is therefore upheld. The recitation "the incentive is a penalty" is contradictory. The term incentive is used to mean a reward while the term penalty denotes a punishment.
3. Applicant's arguments filed 9 June 2006, with respect to the rejection under 35 U.S.C. section 102(b), have been fully considered but they are not persuasive.
4. Applicant's arguments filed 9 June 2006, with respect to the rejection under 35 U.S.C. section 103 have been fully considered but they are not persuasive.
5. Applicant argues (with respect to claims 1 and 10) that Barns-Slavin fails to disclose a second memory portion operatively connected to the processor for concurrently storing temporary rate data, wherein the processor determines a rate applicability determination using the rating instruction data, the primary rate database and the temporary rate data. However, Examiners notes that Barns-Slavin discloses a second memory portion which stores rate data that

can be updated from time to time (C. 3, lines 41-49). Further, Barns-Slavin discloses a processor determines discounted shipping costs for the group in accordance with the stored weights and stored portion of the shipping data and the stored rates (C. 2, lines 39-45).

6. Applicant argues (with respect to claims 16 and 19) that Barns-Slavin fails to disclose obtaining or using incentive related usage data to determine the effectiveness of the discount or whether the discount should be modified based on the incentive usage data. However, Examiner notes that Barns-Slavin discloses the data processor compares the discounted shipping cost with shipping costs for the parcels in the group considered as separate items and processes each parcel of the group as a separate item. Therefore, if the usage data or amount of parcels do not meet certain usage criteria the discount is not received. Moreover, Barns-Slavin discloses redetermining the discounted shipping cost if the group still meets the predetermined usage criteria (C. 2, lines 57-67).

7. Applicant argues (with respect to claims 16 and 19) that Barns-Slavin fails to disclose obtaining incentive related usage data. However, Examiner notes that Barns-Slavin discloses determining whether the group meets the requirements for the discount and obtains data (i.e. usage data) on the amount of parcels needing shipped. If the parcels meet the requirement then the group receives the discount.

8. Applicant argues (with respect to claim 18) that Barns-Slavin fails to disclose a time-based discount. However, Examiner notes “time-based discount” taken in its broadest reasonable interpretation is discounts allowed only after a certain cumulative total dollar amount, number of pieces, or weight have been shipped using a particular class of service (C.2, lines 7-

10). Further, Barns-Slavin discloses rate data that may be changed by updating data from time to time (C. 3, lines 45-49).

9. Applicant argues (with respect to claims 3-4) that Barns-Slavin fails to disclose a temporary database. However, Examiner asserts that Barns-Slavin discloses a memory portion that contains rate information that can be replaced or updated (C. 3, lines 41-49).

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, Barns-Slavin discloses a temporary memory storing rate information in which the data may be updated from time to time.

11. Applicant argues (with respect to claim 12) that Barns-Slavin fails to disclose receiving customer data for a plurality of customers. Examiner noted that Barns-Slavin failed to explicitly disclose the limitation. However, Examiner notes that Barns-Slavin discloses receiving usage data (a total dollar amount, number of pieces, or weight) have been shipped (C. 7, lines 7-10).

12. Applicant argues (with respect to claims 13) that the references do not disclose receiving data relating to customer usage of the discount; and determining whether to adjust the discount. However, Sansone et al. teaches a data center which stores usage data of the mailers and determines whether the mailers qualify for extra discounts based on their use of previous discounts. Sansone et al. also discloses determining at the data center those mailers due to

commonality of usage patterns whose batch mailings would more likely be combinable to optimize discounts (C. 4, lines 25-43). The claim as written does not recite using the previous use of a discount to determine if that discount should be adjusted. However, Examiner notes that Barns-Slavin discloses the data processor compares the discounted shipping cost with shipping costs for the parcels in the group considered as separate items and processes each parcel of the group as a separate item. Therefore, if the usage data or amount of parcels do not meet certain usage criteria the discount is not received. Moreover, Barns-Slavin discloses redetermining the discounted shipping cost if the group still meets the predetermined usage criteria (C. 2, lines 57-67).

***Claim Rejections - 35 USC § 112***

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. As per Claim 19, the recitation of the phrase “the incentive is a penalty” is vague and indefinite. It is unclear to the Office what the Applicant means by incentive. Appropriate correction is required in the indicated claim and any subsequent recitations.

***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1, 10 and 14-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Barns-Slavin et al., U.S. Patent No. 5,995,950.

As per **Claims 1 and 10**, Barns-Slavin et al. disclose a mailing machine comprising:

- a processor (Col. 2, lines 20-47);
- a first memory portion operatively connected to the processor for concurrently storing a primary rate database (Col. 2, lines 20-47);
- a second memory portion operatively connected to the processor for storing temporary rate data (Col. 3, lines 45-49);
- a third memory portion operatively connected to the processor for storing rating instruction data (Col. 2, lines 20-47); and
- wherein the processor determines a rate applicability determination using the rating instruction data, the primary rate database and the temporary data (Col. 2, lines 20-47).

As per **Claim 16 and 19**, Barns-Slavin et al. disclose a mailing machine comprising:

- obtaining customer usage and customer data (Col. 2, lines 7-10; Col. 4, lines 48-50);

- determining whether offering an incentive is desired (Col. 4, lines 19-25);
- determining whether a customer is eligible for an incentive (Col. 2, lines 20-47);
- offering the customer the incentive (Col. 3, lines 37-44);
- obtaining incentive related usage data (Col. 2, lines 7-10); and
- analyzing the incentive related usage data to determine effectivity, determining whether to modify the incentive (Col. 2, lines 20-47).

As per **Claim 17**, Barns-Slavin et al. disclose a mailing machine comprising:

- the customer usage data is obtained from a mailing machine (Col. 2, lines 7-10).

As per **Claim 18**, Barns-Slavin et al. further discloses a mailing machine wherein:

- the incentive is a time based discount for at least one particular class of mail (Col. 2, lines 7-10).

#### ***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 2-5, 8-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barns-Slavin et al., U.S. Patent No. 5,995,950.

As per Claims 2 and 11, Barns-Slavin et al further discloses a mailing machine comprising:

- wherein the processor determines a rate determination using the rating instruction data and usage data and determines a rate applicability determination using the rate determination and the primary rate database (Col. 2, lines 20-47).

Barns-Slavin et al. fails to explicitly disclose a fourth memory portion operatively connected to the processor for storing usage data. However, Barns-Slavin et al. disclose discounts being allowed only after a certain amount of items have been shipped (Col. 2, lines 7-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include storing the usage data within a memory, because it provides an easily implemented and flexible system for determining discounted shipping charges for users.

As per Claim 3, Barns-Slavin et al further discloses a mailing machine comprising:

- wherein the processor determines a rate applicability determination further using the temporary rate database.

Barns-Slavin et al. fails to disclose a temporary rate data comprises a temporary rate database having expiration data. However, Barns-Slavin et al. discloses replaceable memory so that rate data may be updated from time to time (Col. 3, lines 45-49). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include a temporary rate database having expiration

data, because it greatly improves the system by providing the system with more accurate rate data to determine the discount for the user.

As per Claim 4, Barns-Slavin et al. fails to explicitly disclose wherein:

- a portion of the rate applicability determination is received from an external processor and stored in the temporary rate database.

However, Barns-Slavin et al. discloses a temporary rate database, which may be updated by downloading (from an external processor) to writeable memory (Col. 3, lines 45-49). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include a portion of the rate determination data being received by an external processor, because it greatly improves the system by providing the system with more accurate rate data to determine the discount for the user.

As per Claim 5, Barns-Slavin et al. fails to explicitly disclose wherein:

- a fifth memory portion operatively connected to the processor for storing customer data.

However, Barns-Slavin et al. discloses inputting customer information into the system (Col. 4, lines 48-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include storing the customer data in a memory, because it provides an easily implemented and flexible system for determining discounted shipping charges for users.

As per Claim 8, Barns-Slavin et al. further discloses wherein:

- the temporary rate data is cleared periodically (Col. 3, lines 45-49).

As per Claim 9, Barns-Slavin et al. further fails to disclose a mailing machine wherein:

- the period for clearing the temporary rate data is every 24 hours.

However, Barns-Slavin et al. discloses wherein the temporary rate data is updated from time to time (Col. 3, lines 45-49). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include updating the temporary rate data from time to time, because it greatly improves the system by providing the system with more accurate rate data to determine the discount for the user.

20. Claims **12-13 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Barns-Slavin et al., U.S. Patent No. 5,995,950 in view of Sansone et al., U.S. Patent No. 5,072,401

As per Claim 12, Barns-Slavin et al. further discloses a mailing machine comprising:

- receiving customer data for a plurality of customers (Col. 3, lines 48-50);
- creating a temporary rate database (Col. 3, lines 45-49);
- sending the temporary rate database to the mailing machine (Col. 3, lines 45-49).

Barns-Slavin et al. fails to explicitly disclose receiving customer data for a plurality of customers. However, Barns-Slavin et al. discloses receiving usage data of a customer (Col. 2,

lines 7-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include receiving usage data from a plurality of customers, because it provides an easily implemented and flexible system for determining discounted shipping charges for users.

Barns-Slavin et al. fails to disclose:

- obtaining logistics data for a mailing logistics system (Col. 3, lines 50-65);
- determining desired volume changes by class (Col. 3, lines 50-65);
- targeting at least one customer having a mailing machine for a discount in the class (Col. 16, lines 3-6).

However, Sansone et al. teaches a mailing system which obtains logistics data for a mailing logistics system, determines the volume changes of batch mail, and determines which mailers to provide a discount to (Col. 3, lines 50-65; Col. 16, lines 3-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include obtaining logistics data, determining volume changes by class, and targeting customers of that class for a discount as taught by Sansone et al., because it greatly improves the system by enabling a more efficient and effective use of the facilities of the post office.

As per **Claim 13**, Barns-Slavin et al. fails to disclose a mailing machine comprising:

- receiving data relating to customer usage of the discount; and determining whether to adjust the discount.

However, Sansone et al. teaches a data center which stores usage data of the mailers and determines whether the mailers qualify for extra discounts based on their use of previous discounts (Col. 4, lines 25-43). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include determining whether to adjust the users discounts based on their usage of the discounts as taught by Sansone et al., because it greatly improves the system by providing the users with greater discounts they would not ordinarily be available to them.

As per Claim 20, Barns-Slavin et al. further discloses a mailing machine wherein:

- determining whether an incentive is desired includes, analyzing historical usage data (Col. 2, lines 7-10; Col. 4, lines 19-25).

Barns-Slavin et al. fails to explicitly disclose analyzing partial period usage data. However, Barns-Slavin et al. discloses analyzing usage data (Col. 2, lines 7-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include analyzing partial period usage data, because it greatly improves the efficiency of the system by providing the system with more accurate rate data to determine the discount for the user.

Barns-Slavin et al. fails to disclose forecasting capacity demands and targeting at least one customer likely to require the applicable mailing services to be discounted. However, Sansone et al. teaches using logistics planning in order to ensure timely delivery of mailings, and also targets mailers with common usage patterns (Col. 3, lines 50-65; Col. 16, lines 3-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's

invention to modify the mailing machine of Barns-Slavin et al. and include forecasting capacity demands and targeting customers with common usage patterns as taught by Sansone et al., because it greatly improves the system by enabling a more efficient and effective use of the facilities of the post office.

21. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barns-Slavin et al, U.S. Patent No. 5,995,950 in view of Huxter, Pub. No. US2002/0107820 A1.

As per Claims 6-7, Barns-Slavin et al. fails to disclose a mailing machine comprising:

- at least a portion of the customer data is obtained utilizing a cookie, and at least a portion of the rate determination is received from an external processor that received the cookie.

However, Huxter teaches using cookies to obtain user information (Paras. 180 and 183). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include cookies to obtain customer data as taught by Huxter, because it greatly improves the convenience of the system by providing the user with convenience and a system that is user-friendly.

### *Conclusion*

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr  
Examiner  
Art Unit 3639

FSJ

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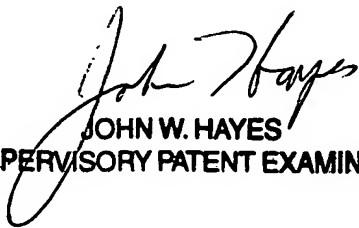
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Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314

  
JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER